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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

BINA.P004.US

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on July 16, 2010

Signature

Typed or printed name David B. Dort

Application Number

10/595,446

Filed

April 20, 2006

First Named Inventor

Ralph ZOCHERT

Art Unit

3617

Examiner

Lars OLSON

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒ attorney or agent of record.  
Registration number 50,213☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

  
Signature

David Bogart Dort

Typed or printed name

571-338-6037

Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Ralph Zochert  
Application Serial No. 10/595,446  
Filing Date: 4/20/2006  
For: HANDRAIL

Examiner: Lars A. Olson  
Art Unit: 3617  
Confirmation No: 9797  
Attorney Docket No.: BINA.P004.US

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Date: July 16, 2010 \_\_\_\_\_

By:/s/ \_\_\_\_\_

STATEMENT ACCOMPANYING REQUEST FOR PRE-APPEAL BRIEF  
REVIEW

Dear Sir/Madam:

This statement accompanies the simultaneous filed Notice of Appeal and Pre-Appeal Brief Request for Review.

Claims 1, 2 and 7-9 were rejected in a Final Office Action of February 16, 2010, were rejected as being unpatentable (under 35 USC 103) over Carmichael (4,683,900) in view of Jaynes et al (5,504,342). Claims 3-6 and 10-11 were allowable.

**Rejection of claims 1, 2 and 7-9 under 35 USC 103**

The Examiner's rejection of claims 1,2 and 7-9 was improper. Claim 1 of the invention recites (1) a handrail attached to (2) a tarpaulin cloth having (3) a handlebar between (4) two bushes which each have a (5) screw thread that is (6) inserted through the tarpaulin cloth and (7) fastened to the tarpaulin frame thus (8) affixing the bushes to the tarpaulin frame.

The Applicant asserts that a Graham test is appropriate in evaluating the Examiner's rejection. The Graham Factors are:

**(a) Determining the scope and contents of the prior art**

The examiner has cited Carmichael in view of Jaynes in making his obviousness rejection.

**(b) Ascertaining the differences between the prior art and the claims in issue**

Structurally, the cited references disclose the entirety of the claimed invention. Carmichael discloses (2) a tarpaulin cloth (7) a tarpaulin frame having tubular frame members, which are attachable to a boat. Also disclosed is a (3) pair of handles attached to the tarpaulin. Jaynes discloses a (1) handrail made of a tubular member that is supported on either side by a (4) pair of mounts. Each mount is said to have a (5) fastening screw to (6, 8) connect the mount to a surface.

Where the claims of the invention differ from the prior art is that the handrail of the invention is connected to the tarpaulin frame with the tarpaulin in-between the two. The handrail of Jaynes is disclosed to connect to the structure of the boat. The tarpaulin support railing is a structure on a boat.

Jaynes, however, teaches away from the claimed invention. Jaynes (at col. 2, lns. 15-19) states that "[t]here is thus a need for an ultraviolet fishing light which may be permanently mounted on the exterior of a boat, which properly illuminates florescent fishing line disposed in the immediate vicinity of the hull of a boat." It further states (at col. 1, lns. 38-40) that "a light useful for night fishing on a boat must be directed away from the deck of the boat so that it will illuminate the water in the immediate vicinity of the hull." Jaynes thus teaches that for its invention to properly function, it must be near the water near the hull.

The claimed invention discloses the opposite of Jaynes. It discloses a handrail located on a tarpaulin frame. These frames are almost always located above the

boat passengers and are usually the structures on a boat that are the farthest from the water and the hull. Taken as a whole, I think the claimed features of the invention are present in the prior art references, but that Jaynes teaches away from the claimed invention. The combination of the two references would not lead to the claimed invention. This is because one skill in the art would not be motivated to combine the references because Jaynes teaches away from the placement of a handrail on the tarpaulin frame of Carmichael.

**(c) Resolving the level of ordinary skill in the pertinent art**

This Graham factor will not be discussed because Jaynes teaches away from the present invention. The Applicant reserves the right to present arguments on appeal related to skill in the pertinent art.

**(d) Evaluating evidence of secondary considerations.**


The secondary considerations include evidence of “unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts” when present. MPEP 2141(III). The Applicant reserves the right to present arguments regarding these factors on appeal or in a Request for Continuing Examination.

### **Summary**

Based on the analysis of the *Graham* factors, it is believed that the claimed invention is non-obvious in view of the two cited references. This is because one of the references teaches away from the present invention.

For the above-stated reasons, the Applicant asks the Review Panel to recommend that the Examiner reopen prosecution and allow the claims, instead of proceeding to Appeal. In the alternate, the Applicant requests that the Review Panel recommend a withdrawal of the Final Rejection.

Respectfully submitted,  
Dort Patent, P.C.

A handwritten signature in black ink, appearing to read "David Bogart Dort" with a stylized flourish.

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July 16, 2010  
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